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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,051	06/21/2000	Michael J. Witz	2043.197US1	7802
49845	7590	03/24/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 03/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/599,051	Applicant(s) WITZ ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 27, 2005 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to aggregating preferences, and deriving products used by a second population.
 - II. Claims 13-20, drawn to generating a subset of preferences, and identifying position changes of a mutual fund from the subset.

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3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as identifying position changes for a mutual fund from a weighted subset of recommended securities. See MPEP § 806.05(d).

4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Joe Mehrle on March 8, 2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is respectfully advised to cancel claims 31-20, drawn to the non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites “wherein the first population of users is associated with investment analysts” and “second population of users associated with investors.” The phrase “associated with” renders the claim indefinite because “associated with” could have multiple interpretations, and therefore one is unable to determine the metes and bounds of the claim language.

9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites “having a capitalization and a trading volume consistent with the objectives of the mutual fund.” The phrase “objectives of the mutual fund” renders the claim indefinite because the objectives of a mutual fund can vary over time, and by investor. It would be inappropriate for the scope of the claim to change over time, and therefore the claim is indefinite because it fails to establish the metes and bounds of the claim language.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, rejected under 35 U.S.C. 102(e) as being anticipated by Reese, U.S. Patent No. 6,236,980.

Claim 1, Reese discloses a system and method for receiving and reporting investment security recommendations from investment analyst sources, including receiving over a wide-area network (figure 3), an indication of a preference of a user from a first population of users, wherein the first population of users is associated with investment analysis (column 12 lines 11-16, 35-38, and figure 7), aggregating preferences into a database (figure 14, #342), and deriving a financial product for a second population from the set of preferences, the second population being associated with investors (column 2 line 40 – column 3 line 54).

Claim 2, Reese teaches the financial product being mutual funds (column 56 lines 59-67).

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Claim 3, Reese teaches associating each preference with a ranking of a submitting user, and screening the preferences based on the ranking (column 30 lines 30-32 and column 21 lines 10-31).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese.

Claim 8, Reese teaches receiving a request for information about a mutual fund (column 15 lines 24-36, column 56 line 67). Reese fails to teach the steps of serving a page reflecting current holdings of the mutual fund.

Official notice is taken that the current holdings of a mutual fund is an old and well-known component of information about a mutual fund. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Reese to include a display of mutual fund holdings in the mutual fund holding information report, thereby providing complete information about the mutual fund.

Claims 9, 12, Reese fails to teach distributing reports as an electronic newsletter, updated with a frequency greater than weekly.

Official notice is taken that the distribution of semi-weekly newsletters is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include the distribution of a semi-weekly newsletter, because it would automate the process of a user receiving recommendation information, without the need for the user to manually retrieve the data, and since investment data can be extremely time sensitive, the newsletters would be more effective if they are distributed more frequently.

Claim 10, Reese teaches screening the set of preferences to generate a recommendation list (column 2 lines 40-55).

Claim 11, Reese teaches screening based on investment style of the recommended list, and generating reports based on the screening (column 57 lines 13-29).

15. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, as applied to claims 1 and 2 above, and further in view of Segal et al., U.S. Patent No. 6,049,783.

Claim 4, Reese fails to teach identifying a subset having capitalization and a trading volume consistent with objectives of a mutual fund.

Segal teaches a method of sorting, filtering, and reporting criteria as a means for timely processing online financial data. Segal teaches criteria being selected from trading volume and capitalization (claims 15 and 18). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include the selection criteria of trading volume and capitalization because such statistics are helpful in making investment decisions on a security.

Claim 5, Reese teaches screening preferences based on the ranking of the submitting user (column 30 lines 30-32 and column 21 lines 10-31).

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, as applied to claim 1 above, and further in view of Phillips et al., U.S. Patent No. 6,473,084.

Claim 6, Reese fails to teach providing rewards based on a reward structure to submitters of high performing model portfolios.

Phillips discloses a system and method for inputting predictions of financial data. Phillips teaches ranking users who submit predictions, and providing rewards to those who repeatedly predict accurately (column 61 lines 36-53). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include the reward structure of Phillips because this feature provides motivation for analysts to most honestly recommend the securities as best they can, creating a more accurate system.

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, as applied to claims 1 and 2 above, and further in view of Wallman, U.S. Patent No. 6,338,047.

Claim 7, Reese fails to teach receiving investor currency units, and establishing a new position of security in the mutual fund.

Wallman discloses a system and method for allowing a plurality of investors to manage investments in a mutual fund, wherein users submit preferences, and adjusting mutual fund holdings in response to these preferences (column 4 lines 5-7, 20-24, 33-40). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include establishing new investment positions in a mutual fund because based on the recommendation data of Reese, a user is able to make informed decisions about investment positions, and as

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the data changes, these positions may change as well, and the mutual fund should preferably reflect these changes in market conditions.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wallman, U.S. Patent No. 6,601,044 is directed towards a system for creating a portfolio of assets and executing trades in the assets to modify the portfolio.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HANI M. KAZIMI
PRIMARY EXAMINER